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PATENT  
Docket No.: 002558-064410US  
Client Ref. No.: BRP0098

On 8/8/02

TOWNSEND and TOWNSEND and CREW LLP

By: Melba M. Murrell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Quan Nguyen

Application No.: 10/092,926

Filed: March 6, 2002

For: ASSAY SYSTEM FOR  
SIMULTANEOUS DETECTION AND  
MEASUREMENT OF MULTIPLE  
MODIFIED CELLULAR PROTEINS

Examiner: Unknown

Art Unit: Unknown

PETITION UNDER 37 C.F.R. 1.47(a)

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AUG 28 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to the provisions of 37 C.F.R. 1.47(a), Applicant hereby petitions for filing of the above-identified patent application when a joint inventor cannot be found or reached after diligent effort. Proof of the pertinent facts is submitted herewith, in the form of a Declaration by Cathryn Green setting forth the efforts made to find or communicate with the inventor in question, Dr. Yong Song.

As set forth in the declaration, Dr. Song has not been employed by the assignee, Bio-Rad Laboratories, Inc. for more than one year. Attempts have been made to contact Dr. Song by mail and by telephone at his last known address and telephone number, but these did not succeed in establishing a contact, and no replies to messages or to written correspondence have been received.

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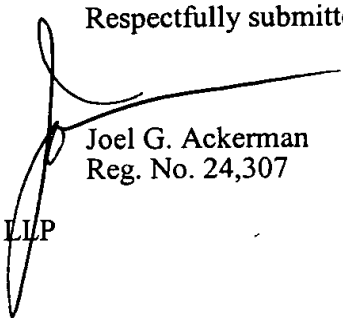
Attached as exhibits to the declaration are copies of a letter sent to Dr. Song on March 11, 2002, and a tracking notice from the delivery service, Airborne Express, indicating that the letter was ultimately returned to that company, indicating that they had been unable to contact Dr. Song.

Submitted herewith are an assignment from the other inventor in this application, Dr. Quan Nguyen, to Bio-Rad, together with a Declaration signed by him. Also submitted, attached hereto, is a copy of Dr. Song's employment agreement, showing that Dr. Song has agreed to assign this application to Bio-Rad and that Bio-Rad therefore has the right to prosecute this application on behalf of Dr. Song.

In view of the situation that the co-inventor, Dr. Song, cannot be reached after diligent efforts have been made, Applicant requests that this application be filed on behalf of the joint inventors pursuant to 37 C.F.R. 1.47 (a).

If there are any questions, please telephone the undersigned.

Respectfully submitted,

  
Joel G. Ackerman  
Reg. No. 24,307

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (415) 576-0200  
Fax: (415) 576-0300  
JA:ja

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**BIO-RAD**

Bio-Rad Laboratories, Inc.  
Corporate Payroll Office  
1000 Alfred Nobel Drive  
Hercules, CA 94547  
Telephone: (510) 741-6158  
Facsimile: (510) 741-5859



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# Employment Agreement

The following agreement between Bio-Rad Laboratories, Inc., a Delaware corporation (hereinafter "Bio-Rad"), and myself, is voluntarily entered into and supersedes all previous agreements, if any, between myself and Bio-Rad relating to the subject matter of this agreement. My obligations under this agreement are made in consideration of the compensation now and hereafter paid to me by Bio-Rad and other consideration. Accordingly, I hereby agree that:

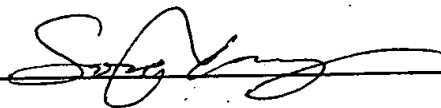
1. As an employee of Bio-Rad, I will devote my best efforts to the interest of Bio-Rad and will not, without written consent of Bio-Rad during my employment, engage in any activity, investment, interest or association
  - (1) which is hostile or adverse to or competitive with Bio-Rad, or
  - (2) which so occupies my attention as to interfere with the proper and efficient performance of my duties at Bio-Rad, or
  - (3) which interferes with the independent exercise of my judgement in Bio-Rad's best interest.
2. In view of the fact that my work as an employee of the company will bring me into close contact with many confidential affairs of Bio-Rad, I will at all times during the term of my employment and thereafter hold in strictest confidence, and not use or disclose to anyone outside Bio-Rad without express written authorization of an officer of Bio-Rad, any confidential or proprietary information of Bio-Rad, including "know-how," formulae, secret processes or machines, inventions, and matters of a business nature, to the extent not available to the public. I agree to consult with my supervisor at Bio-Rad concerning any questions that I may have as to what comprises such confidential or proprietary information.
3. All inventions (including new contributions, improvements, designs, developments, ideas, discoveries; copyrightable material, or trade secrets) which I may solely or jointly conceive, develop, or reduce to practice during the period of my employment by Bio-Rad shall be assigned to Bio-Rad. My obligation to assign, however, shall not apply to any invention as to which I can prove:
  - a. was developed entirely on my own time and
  - b. no equipment, supplies, facility, or trade secret information of Bio-Rad was used, and
  - c. (i) does not relate
    - (1) to the business of Bio-Rad or
    - (2) actually or demonstrably anticipated research or development of Bio-Rad or
  - (ii) does not result from any work performed by me for Bio-Rad.
4. Notwithstanding the foregoing, I also agree to assign to or as directed by Bio-Rad all my right, title and interest in and to any and all inventions, discoveries, developments, improvements or trade secrets, full title to which is required to be in the United States by a contract between Bio-Rad and the United States or any of its agencies.
5. I have attached hereto a list describing all inventions, developments, designs, improvements and trade secrets belonging to me and made by me prior to my employment with Bio-Rad that I wish to have excluded from this agreement. If no such list is attached, I represent that there are no such inventions. If, while employed by Bio-Rad, I incorporate into a product, process, machine, or otherwise use an invention owned by me or in which I have an interest, Bio-Rad shall be and hereby is granted a royalty-free, irrevocable, worldwide license to make, have made, use and sell that invention, without restriction, to the extent of my ownership and interest.
6. I will advise Bio-Rad promptly in writing of any inventions, discoveries, developments, improvements or trade secrets that are subject to the Agreement, including those that I believe meet the criteria in subparagraphs 3(a), (b) and (c), above; and I will at the time provide to Bio-Rad in writing all evidence necessary to substantiate that belief. I understand that Bio-Rad will keep in confidence and will not disclose to third parties without my consent any confidential information I disclose in writing to Bio-Rad relating to inventions which meet the criteria of subparagraphs 3(a), (b) and (c) above.

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7. I will execute any proper oath or verify any proper document in connection with carrying out the terms of this agreement. In the event Bio-Rad is unable, because of my mental or physical incapacity or for any other reason whatsoever, to secure my signature to apply for, or to pursue, any application for any United States or foreign patent, covering inventions assigned to Bio-Rad as stated above, I hereby irrevocably designate and appoint Bio-Rad and its duly authorized officers and agents as my agent and attorney-in-fact to act for any in my behalf and stead to execute and file any such applications and to do all other lawfully permitted acts to further the prosecutions and issuance of U.S. and foreign patents and copyrights thereon with the same legal force and effect as if executed by me. I further agree to testify at Bio-Rad's request and expense in any interference, litigation, or other legal proceedings which may arise during or after my employment.
8. I will, at the time of leaving the employ of Bio-Rad, return to Bio-Rad all drawings, blueprint, notes, memoranda, specifications, designs, devices, documents, and any other material containing or disclosing any confidential or proprietary information. I will not keep in my possession any such materials without Bio-Rad's written approval.
9. I will not, during my employment at Bio-Rad, improperly use or disclose any proprietary information or trade secrets of my former or concurrent employers or companies, if any, and shall not bring to the premises of Bio-Rad any unpublished documents or any property belonging to such former or concurrent employer or company, unless consented to in writing by said employers or companies.
10. To the best of my knowledge, there is no other contract to assign inventions that is now in existence between myself and any other person, corporation or partnership, unless a copy of such a contract is attached hereto.
11. This agreement shall be governed for all purposes by the laws of the State of California as such law applies to contracts to be performed within California by residents of California. If any provision of this agreement is void or so declared, such provision shall be severed from this agreement, which shall otherwise remain in full force and effect.

IN AGREEMENT, I have signed my name this 28<sup>th</sup> day of FEB, 192000.

Employee Signature



Inventions listed on attachment:



Yes



No

Witness Signature



PATENT: HMUNC 13 - A GLUCOSE REGULATED GENE  
US PATENT 60/069,352 (Dec. 12 1997)  
PCTPATENT CA P8/01061 (Nov. 11, 1998)  
INVENTORS: MEL SILVERMAN, YANG SONG



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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Quan Nguyen et al.

Application No.: 10/092,926

Filed: March 6, 2002

For: ASSAY SYSTEM FOR  
SIMULTANEOUS DETECTION AND  
MEASUREMENT OF MULTIPLE  
MODIFIED CELLULAR PROTEINS

Examiner: Unknown

Art Unit: Unknown

DECLARATION UNDER 37 C.F.R. 1.47

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**AUG 28 2002**

**OFFICE OF PETITIONS**

Assistant Commissioner for Patents  
Washington, D.C. 20231

CATHRYN GREEN declares and states:

1. I am a Staff Administrative Associate in the Legal Department of Bio-Rad Laboratories, Inc., Hercules, California.

2. I make this Declaration in support of a petition under 37 C.F.R. 1.47 to allow attorneys at Townsend and Townsend and Crew, Two Embarcadero Center, 8th Floor, San Francisco, California 94111, to prosecute the above-identified patent application on behalf of Bio-Rad Laboratories, Inc. under circumstances where one of the inventors, Dr. Yong Song, cannot be contacted, despite diligent efforts to do so.

3. On information and belief, Dr. Song was employed at Bio-Rad until approximately more than one year ago.

~~08/20/2002-61000077-00000077-201477-10092926~~  
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4. The last known address for Dr. Song in our records is: 629 Miller Avenue, Apt. 2, South San Francisco CA 94080.

5. On March 11, 2002, I sent Dr. Song, via Airborne Express courier service, at that address, a letter with documents for his signature in connection with filing a PCT application. Included with the documents was a prepaid, preaddressed return envelope. A copy of my cover letter is attached as Exhibit A.

6. After receiving no response to my letter, I attempted to contact Dr. Song by telephone on March 18, March 29 and April 11, 2002. Each time the telephone was answered by an answering machine. I left a message on each call asking Dr. Song to contact me about the documents. However, I never received any return telephone calls or messages.

7. On May 8, 2002, I received a tracking notice from Airborne Express (Exhibit B, attached), which indicates that my March 11, 2002 letter with the documents was returned to Airborne Express on April 15, 2002. This indicates that, despite multiple attempts, Airborne Express was unable to locate Dr. Song to deliver my March 11, 2002 letter.

8. To the best of my knowledge, we have still received no communication from Dr. Song, despite the letter and telephone calls.

9. I also conducted a search for Dr. Song using a "people locator" feature of an Internet search engine. This search produced a list of some 75-80 individuals named Yong Song, located in various parts of the United States. With so many possibilities, and the list not necessarily being complete, it was impractical, if not impossible, to try to contact all these individuals to ascertain whether one of them might be the inventor named in the above-identified Application.

Quan Nguyen  
Application No.: 10/092,926  
Page 3

PATENT

I understand that the above statements were made with the knowledge that willful false statements and the like are punishable by fine and/or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statement may jeopardize the validity of the subject patent application or any patent resulting therefrom.

Dated: August 5, 2002

By: Cathryn Green  
Cathryn Green

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Bio-Rad  
Laboratories

Corporate Offices  
1000 Alfred Nobel Drive  
Hercules, California 94547  
Telephone: (510) 724-7000  
Facsimile: (510) 741-5815



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March 11, 2002

**VIA AIRBORNE EXPRESS**  
**Ph# 650-873-0761**

Dr. Yong Song  
629 Miller Avenue, Apt. 2  
South San Francisco, CA  
94080

Re: New International Patent Application in PCT

Corresponding to US Serial No.: 60/274,130, Filed: March 7, 2001  
Entitled: "Assay System for Simultaneous Detection and Measurement of Multiple Modified Cellular Proteins"  
Applicant: Bio-Rad Laboratories, Inc.  
Inventors: Yong Song, Quan Nguyen

Dear Dr. Song:

I am enclosing Inventor documents for the above-referenced PCT International Patent Application. Please sign where indicated on the attached PCT Request form.

As we are working with a deadline, I will need to have this document sent back to me as soon as possible. I am enclosing a pre-paid, self-addressed Airborne Express envelope for you to return the completed document to my attention at Bio-Rad Laboratories, Inc.

Thank you for your cooperation and prompt attention to this matter. Please do not hesitate to call should you have any questions. I can be reached at 510-741-6099.

Sincerely,

Cathy Green  
Staff Administrative Associate  
Bio-Rad Laboratories, Inc.

: cg

**Enclosures**

cc: Henry Heines (w/o enc.)



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SHIP	TRANSIT TIMES	RATES	PICKUPS	LOCATIONS
BY TRACKING NUMBER	BY REFERENCE	BY MAIL	SKY COURIER SHIPMENTS	

## TRACKING RESULTS: DETAILED VIEW

Tracking Number: 15374004052

## Shipment Summary:

Current Status: Freight returned. Call 1-800-AIRBORNE for update.  
 Delivered on: Apr 15 2002 8:21 pm  
 Delivered to:  
 Signed for by: LD-FD

## Shipment History:

Date	Time*	Activity	Location**
Apr 15 2002	8:21 pm	Freight returned.	San Francisco, CA
Mar 12 2002	10:00 am	Delivered.	Oyster Bay, CA
	7:56 am	Arrived at Airborne.	Oyster Bay, CA
	1:24 am	Left Airborne.	Fresno Truck Hub, CA
Mar 11 2002	1:20 pm	Picked up by Airborne.	Shipper's Door

\* status times reflect the time zone where the update took place.

\*\* cities reflect the Airborne terminal servicing the area.

## Shipper:

BIO RAD LABORATORIES  
 HERCULES, CA 94547

## Receiver:

DR. YONG SONG  
 SOUTH SAN FRANCISCO, C

## Shipment Detail:

Service:	Next Afternoon	Ship Type:	Letter Express
Weight:	1	Description:	
Pieces:	1	Shipper's Reference:	
		Special:	

Tracking request generated on 5/8/02 at 3:06:24 PM.

If you have any further questions, please contact Customer Service at  
 1-800-AIRBORNE (1-800-247-2676) or write to us.

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